

### **REMARKS**

The Official Action dated November 6, 2003 has been carefully considered.

Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

Claims 26-30 have been cancelled to reduce issues for appeal. Since these changes do not involve any introduction of new matter or raise any new issue, entry is believed to be in order and is respectfully requested.

In the Official Action, claims 26-27 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Newfield et al., "Scratchpad: Mechanisms for Better Navigation in Directed Web Searching", 1998 (hereafter "Newfield") in view of Gennaro (US Patent No. 5,742,768). Each of claims 26-27 and 30 now have been cancelled, thereby mooted the Examiner's rejection of those claims.

Claims 28-29 and 31-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Newfield in view of Gennaro and further in view of Jain (US 2003/0030679). In making this rejection, the Examiner conceded that neither Newfield or Gennaro teach the non-linking functionality of copying any associated graphical elements corresponding to the hyperlink to the second window, wherein the associated graphical element comprises a graphical image embedded in the hyperlink. The Examiner took the position that Jain teaches the step of copying any associated graphical element embedded in the hyperlink to the second window and, based upon that premise, asserted it would have been obvious to one of ordinary skill in the art to modify Newfield with Gennaro and Jain in order to make it easier for the user to recognize the hyperlink by viewing its associated graphical image.

However, as will be set forth in detail below, it is submitted that the methods of claims 31-33 are non-obvious over and patentably distinguishable from the teachings of

Newfield in view of Gennaro and further in view of Jain. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 31, the present invention is directed to a method of operating a computer in which, inter alia, the non-linking functionality of automatically copying a hyperlink to a second window in response to a selection includes copying a graphical image **embedded in the hyperlink** to a second window.

Newfield discloses activating a program or option in a browser and then upon selection of a hyperlink copying the hyperlink to a list rather than opening the hyperlink. When the program (Scratchpad) is activated, the user only has one option when selecting a hyperlink. That option being the copying of the hyperlink to a list for later viewing. As noted by the Examiner, Newfield does not disclose any visual generation of options presented to the user upon designation of a hyperlink. In addition, Newfield does not disclose a plurality of individually selectable user options presented to a user in response to designation of a hyperlink.

The Gennaro et al. reference discloses a method for providing a web page having an embedded hyperlink menu to a web browser and for displaying the web page to a user of the web browser. When a user moves a pointer over a hyperlink, a drop down menu with additional related hyperlinks is displayed. The user may select the original hyperlink or one of the additional hyperlinks in the drop down menu. Despite displaying additional hyperlinks, the user either clicks on and follows a particular hyperlink or ignores the hyperlink. The user selectable options displayed in the drop down menu as disclosed by the Gennaro et al. reference consist only of linking functionality options (i.e. open the webpage corresponding to the hyperlink. In addition, as noted by the Examiner, Gennaro fails to teach any non-linking functionality, wherein the non-linking functionality further comprises copying any associated graphical elements corresponding to the hyperlink to the second

window, and further wherein the associated graphical element comprises a **graphical image embedded in the hyperlink**.

Jain discloses a method and system for bookmarking a favorite page with a user-defined image. The method comprises the steps of displaying a website page along with its locator address; displaying a plurality of images on the page; allowing a user to manually select one of the images; and storing the image together with the locator address for the displayed page to bookmark the website page. While Jain allows a user to manually select any image displayed on a webpage to be associated with the URL for the displayed page in a bookmark list, Jain fails to teach or suggest copying any associated graphical elements corresponding to the designated hyperlink to the second window, and further wherein the associated graphical element comprises a **graphical image embedded in the hyperlink**. Jain does not teach or suggest anything about copying a graphical image embedded in the hyperlink. In fact, the method of Jain looks at the entire webpage being displayed and allows a user to select any image to be copied to the bookmark listing for the displayed page (see paragraphs 0022 and 0023).

References relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne*, 203 U.S.P.Q. 245 (C.C.P.A. 1979). Applicants find no teaching by Newfield, Gennaro or Jain, alone or in combination, of a method of using a computer comprising automatically copying a hyperlink including any associated graphical elements corresponding to the hyperlink to a second window, and further wherein the associated **graphical element comprises a graphical image embedded in the hyperlink**. Since none of the references relied upon by the Examiner disclose or suggest that concept, there is no way the references could be combined to meet the limitations of Applicants claims.

Furthermore, to establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). In view of the failure of Newfield, Gennaro or Jain, alone or in combination, to teach, disclose or suggest a method of using a computer comprising automatically copying a hyperlink including any associated graphical elements corresponding to the hyperlink to a second window, and further wherein the associated **graphical element comprises a graphical image embedded in the hyperlink**, Newfield, Gennaro and Jain do not render the presently claimed methods of operating a computer obvious. The methods of the present invention allow a user to select a hyperlink and copy the hyperlink and any graphical image embedded in the hyperlink to a second window, wherein each hyperlink placed in the second window can be individually activated and processed. It is therefore submitted that the presently claimed methods are non-obvious over and patentably distinguishable from Newfield in view of Gennaro et al. and in further view of Jain. Reconsideration is respectfully requested.

Finally, Applicant's appreciate the Examiner granting a telephonic interview with Mr. Geoffrey Oberhaus (Reg. No. 42,955) and Mr. James Liles (Reg. No. 28,320) on November 17, 2003. During the telephonic interview, differences between the presently pending claims 31-33 and Jain were discussed. Applicants asserted that Jain is completely void of any reference to the non-linking functionality of copying a hyperlink and any associated graphical elements corresponding to the hyperlink to a second window, wherein the associated graphical element comprises a graphical image **embedded in the hyperlink**.

Applicants and the Examiner disagreed on the scope of the language of the pending claims; more specifically the phrase "embedded in the hyperlink". Applicants asserted that the quoted language means exactly what it says, i.e., it requires the image to actually be contained in the hyperlink. The Examiner, however, took the position that the phrase

“embedded in the hyperlink” also includes embedded in the target webpage to which the hyperlink points.

The following example may help to clarify the Applicant’s position on the disagreement of the claim scope of the present invention.

A webpage is typically coded in HTML (HyperText Markup Language). A portion of the HTML source code for one exemplary webpage is attached as Appendix A. As can be seen in Appendix A, the HTML source code contains multiple hyperlinks. One hyperlink is as follows:

```
<a href="/2003/11/19/politics/19DEAN.html?8hpib"><br><font  
size="-1">Remains of Dean Brother Found</font></a>
```

One skilled in the art will appreciate that the above is a hyperlink. The hyperlink begins with the hyperlink opening tag “<a href=*“webpage target of hyperlink”*>”, then any text or images to be displayed with the hyperlink are embedded. Images are embedded by using the HTML tag “<img src=*“filename of image”*>”. After all text and images have been embedded in the hyperlink, the hyperlink is closed using the hyperlink closing tag “</a>”. For the above example, the webpage target of the hyperlink is “/2003/11/19/politics/19DEAN.html?8hpib” and the image file “20031119deanpromo.jpg” is displayed along with the text “Remains of Dean Brother Found”.

Under the present invention, the user upon designation of the hyperlink is presented with a plurality of options, with one option including the non-linking functionality of automatically copying the hyperlink and any associated graphical element corresponding to the hyperlink to a second list, wherein the associated graphical element comprises a graphical image embedded in the hyperlink. The user selects the option of automatically copying the

hyperlink and any associated graphical image embedded in the hyperlink to a second list. For the above example, the hyperlink of `<a href="/2003/11/19/politics/19DEAN.html?8hpib">` and the image "20031119deanpromo.jpg" embedded in the hyperlink are copied to a second list.

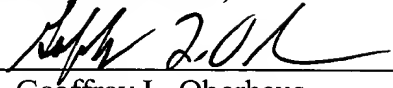
As noted above, the only remaining rejection is based upon the Examiner's assertion that the phrase "embedded in the hyperlink" also includes any images embedded in the target webpage to which the hyperlink points. However, the present invention does not comprise copying any images embedded in the target webpage. Instead, the present invention comprises copying any image embedded in the selected hyperlink of the current webpage.

Applicants believe that anyone skilled in the art would appreciate and understand the difference between a graphic element that is "embedded in the hyperlink" and one that is "embedded in the target webpage to which the hyperlink points". Quite simply, the phrase "embedded in the hyperlink" is limited to any graphical image actually embedded in the hyperlink and does not include any image in the target webpage to which the hyperlink points. It is therefore submitted that the presently claimed methods are non-obvious over and patentably distinguishable from Newfield in view of Gennaro et al. and in further view of Jain, whereby the rejection under 35 U.S.C. §103 has been overcome.

It is believed that the above represents a complete response to the Examiner's rejections under 35 U.S.C. §103 and places the present application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

By



Geoffrey L. Oberhaus  
Registration No. 42,955  
Attorney for Applicants  
DINSMORE & SHOHL LLP  
1900 Chemed Center  
255 East Fifth Street  
Cincinnati, OH 45202  
(513) 977-8623

962660.01

## APPENDIX A

Example portion of HTML webpage source code:

```
<html>

<IMG src="http://graphics7.nytimes.com/images/dropcap/w.gif"
width="46" height="33" align="left" border="0" alt="W">ASHINGTON,
Nov. 19; While the vast power blackout of Aug. 14 had many causes,
it was born in Northern Ohio on an otherwise ordinary afternoon,
according to a government investigation made public today.</p>
<P>An interim report by a United States-Canadian task force
concluded, as had been widely expected, that what could have been
relatively minor failures had cascaded into something much
greater.</p>
<A href="/2003/11/19/politics/19DEAN.html?8hpib"><IMG
Src="http://graphics7.nytimes.com/images/promos/homepage/20031119dea
npromo.jpg" WIDTH="100" HEIGHT="77" BORDER="0" vspace="5"><br><font
size="-1">Remains of Dean Brother Found</FONT></a>
<A href="/2003/11/19/international/asia/19LETT.html?8hpib"><IMG
src="http://graphics7.nytimes.com/images/promos/homepage/20031119jap
anpromo.jpg" WIDTH="100" HEIGHT="77" BORDER="0" vspace="5"><br><font
size="-1">Japan Heads<BR>to Iraq</FONT></a>
```